

1. This form paragraph is to be used when claims are presented to both **combination(s)** and **subcombination(s)** (MPEP § 806.05(c)).
2. In situations involving evidence claims, see **MPEP § 806.05(c)**, example 3, and explain in bracket 3.
3. In bracket 4, suggest utility other than used in the combination.
4. Conclude restriction requirement with one of form paragraphs 8.21.01 through 8.21.03.

The burden is on the examiner to suggest an example of separate utility.

If applicant proves or provides an argument supported by facts, that the other utility, suggested by the examiner, cannot be accomplished, the burden shifts to the examiner to document a viable separate utility or withdraw the requirement.

Argument

In the instant case, the combination is assumed to be invention "I" (remote control over telephone lines) and the subcombination is assumed to be invention "II" (computer control system). The foundation of this argument is that the Applicant's invention does not meet the definition of 700/2 and that all of the

claims relate to one invention. The following statement from the Applicant's patent application is for an alternate embodiment, in which two microprocessors are employed instead on a single microprocessor. All claims in the application make reference to a single processor at each stage of the process. There is no mention of multiple processors being employed to perform a given task at any single stage or location in the claims of the patent application. This alternate embodiment is just a teaching that is offered as enlightenment of possibilities. This alternate embodiment does not meet the definition of class 700, subclass 2, because the processors are only involved in relaying instructions and not in controlling a system.

[0033] It should be noted that, in another embodiment, the functionality of stamp 124 can be divided into two separate but linked microprocessors. The EA router 120A may be in communication with the user's answering machine or some other remote user interface device accessible by a telecommunication system.

In the instant case, the combination as claimed required the particulars of the subcombination as claimed because invention II (computer control system): the multiple processors in the alternate embodiment shared the same job that a single processor performs. Neither the single processor, nor the dual processor would be involved in controlling the actual targeted device, the processor(s)

merely relays the instructions received to the targeted device. The targeted device microprocessor will accept the relayed instructions as programming, and will behave accordingly.

In 806.05(c) Criteria of Distinctness for Combination section "A" states that inventions are distinct if it can be shown that a combination as claimed:

(A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness).

There is no novelty in dividing the workload that can be performed by a single processor into two parts to be performed by two separate processors. The only advantage you get is a more expensive device, which is countered productive. It is further stated in section "B" that:

(B) the subcombination should have utility either by itself or in other and different relations.

The subcombination (invention II) plural processor that are involved in control, are not part of the Applicant's invention and as such have not utility in the claimed invention. Therefore, the restriction should be lifted from the patent application because there are no two distinct inventions in the application, and all claims should be considered.

The claims of combination (I) cannot stand on their own as distinct from the claims of subcombination (II), being that both claims refer to a single microprocessor, and said processor relays instruction. The subcombination requires that there be dual processor involve in the control of a device, the

microprocessor that control the Targeted device is innate to said device and is not part of the Applicant's invention.

In the patent application claim # 70 and # 89 are claims that are assigned to invention "I" and invention "II" respectively. The claims for these two supposedly distinct invention clearly indicate that they are not directly involve in control, but are each involved in relaying instructions from a remote input terminal to a targeted device at a specific site via a central server. The instructions are received by the Applicant's invention and are passed on to the targeted device, which has a processor that is programmed by the instructions that are transmitted by the Applicant's invention. Since both claims are talking about a relaying instructions to a targeted device, and not about being able to control or being able to execute programming that is controls the targeted device. The Applicant's invention does not fall under the classification of class 700, subclass 2 (see definition of class 700, subclass 2).

A Section of Claim 70:

a means for transmitting incoming instructions to a targeted device when reception of incoming instructions is enable;

a means for transmitting said incoming instructions to said device; and

a means for controlling said device based on said instruction.

A Section of Claim 89:

code for determining whether a communication between a central computer and a remote location is contained valid instructions for a device located at said remote location;

code for transmitting any incoming instructions to said device; and
code for controlling said device based on said instructions.

The above citations makes no reference to plural processor, nor does it indicate that the processor in the invention is involve in the control of a targeted device, rather the claims indicate that the processor is involve in relaying instructions to a processor that control the targeted device. The term "Plural Processors" is not mentioned in any of the claims attributed to invention II.

Definition of Classification Class 700 Subclass 2

This subclass is indented under 1. Subject matter where more than one processor is used in a control system and at least one of the processors is programmable.

(1) Note. Classification herein requires active participation by the plural processors in the control system.

Definition of Classification Class 700 Subclass 2 clearly states that one of the processor must be programmable; the processors in the Applicant's invention are not programmable, they perform the same task over and over: relaying acceptable instruction to a targeted device (see above definition). The processor(s) in the Applicant's invention is involved in collecting and passing on instructions to a device that has it's own processor. The targeted device processor is programmable, but said targeted device is not part of the Applicant's invention.

The definition also stipulates that there be active participation by the plural processors in the control system. The Applicant's invention involves several processors, but none of them work together at the same time in controlling a system. The processors at the input site collects instructions and forwards it to the central server that process the input, then the central server processor forwards the process input to a remote location where the Applicant's invention (also has a processor) collect and forwards the input to a targeted device. The instructions transmitted to the targeted device will program said device processor to perform specific activities corresponding to the received input from the remote input terminal. The Targeted device processor is programmed and able to control the functions of said device, not the processors in the applicant's invention, and only one processor is communicating with the Targeted device at the remote location in the application's claims. A Targeted

device cannot receive instruction from two different processors at the same time without the processor being synchronized, and nowhere in the claims is synchronization or plural processors mention.

Claim # 88 in the invention "II" clearly indicates that instructions are relay to a targeted device, and that the device accepting the code will perform a task according to the instructions. The targeted device has a microprocessor that is able to receive the instructions and act upon them. The targeted device microprocessor is the controlling processor, and it is not part of the Applicant's invention.

computer executable software code stored on a computer readable medium, the code for controlling one or more remote device by relaying instructions from an input terminal to said remotely located via a central computer using a communication system, comprising:

code for monitoring a communication network system
for activity incoming from a remote location;

code for determining whether activity on the
communication system enables reception any incoming
instructions from said remote location;

code for storing any incoming instructions when
activity on the communication system enable reception of
incoming instruction at the central computer; and

code for transmitting any received instructions to a
remotely located targeted device;

and controlling said device with said instructions.

Class 700, subclass 2 invention are suppose to be plural processor that are involve in control. The Applicant's invention is not part of the targeted device, and as such it cannot control the electromechanical switches and relay in the targeted device. If the Applicant's invention were to execute the code for starting a targeted device inside of it's own processor, the target device switches and relay would not be affected. The processor that is located in the Applicant's invention, can not effect action in switches and relayed that it is not attached to, it can only forward instructions to the processor in the targeted device telling it how to behave. The behavior of the processor in the targeted device will cause the device to behave in a specific manner that is the direct results on the received instructions from the central server. The invention only relays instruction to the targeted device, it does not control the targeted device.

Since the Applicant's invention fails to meet the definition of Class 700, subclass 2 the restriction is transverse and all claims should be consider as part of one single invention. If the examiner is concern about the possibility of an

alternate embodiment having multiple processors, the Applicant's invention can be cross-reference to class 700, subclass 2. This would not be unusual / exceptional being that it has already been done with the Kuroda et al patent (US: Kuroda et al, 5,757,643)

The fact that the Applicant's invention may fall under two different classifications, does not necessitate that the patent application contain two distinct inventions. The fact that the invention can be classified in part under two different classification and subclass code, only indicate that there may be a need for cross referencing the invention such as the instant of US: Kuroda et al, 5,757,643, which is classified under **700/9**; 200/83WM; 370/419; **379/74**; 379/102.01.

808.02 Related Inventions

Where, as disclosed in the application, the several inventions claimed are related, and such related inventions are not patentably distinct as claimed, restriction under **35 U.S.C. 121** is never proper (**MPEP § 806.05**). If applicant optionally restricts, double patenting may be held.

Where the related inventions as claimed are shown to be distinct under the criteria of **MPEP § 806.05(c) - § 806.05(i)**, the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following:

(A) **Separate classification thereof:** This shows that each distinct subject has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.

(B) **A separate status in the art when they are classifiable together:** Even though they are classified together, each subject can be shown to have formed a separate subject for inventive effort when an explanation indicates a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.

(C) **A different field of search:** Where it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search.

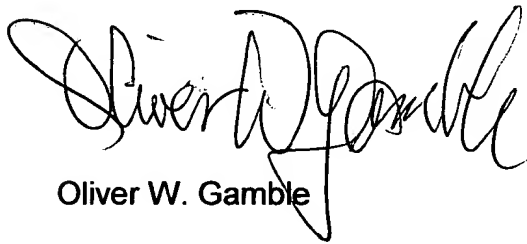
Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions.

In 808.02 Related Inventions ("C") states that if no similar grouping of the classification are found in a search then restriction is valid, however an example is provide showing the 379.4 and 700 classification grouping (US: Kuroda et al, 5,757,643).

Election

I elect invention I: claim 56 – 87, 91, 94, 96, 100, 107, 108, drawn to remote control over telephone lines, classified in class 379, subclass 74 to represent my invention. This election is protested, on the ground that all of the claims related to a single invention and as such there should be no restriction. The invention fails the definition of class 700, subclass 2.

Signed

A handwritten signature in black ink, appearing to read "Oliver W. Gamble". The signature is stylized with large, flowing loops and a prominent vertical stroke at the end.

Oliver W. Gamble